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NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304				
EXAMINER				
ALVAREZ, RAQUEL				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
11/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/776,714

Applicant(s)

KATZ, GARY M.

Examiner

Raquel Alvarez

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This office action is in response to petition filed on 12/9/2008 .
2. Claims 1-65 are presented for examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is indefinite because the claim calls for a method but system components are being claimed. If Applicant wants to claim a method then the body of the claims should read –receiving via a processor using an identification device.....-.
Correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 7-12, 13-21, 23-32, 33-37, 39-46, 59-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Kepecs (7,552,069 hereinafter Kepecs)

With respect to claims 1, 19-21, 23-25, 27-29, 62, 64 Kepecs teaches a computer implemented method (Abstract). A processor receiving, via an identification device, identification information from a consumer (i.e. loyalty cards ids)(col. 7, lines 7-22); a processor storing in computer memory record of promotions received by said consumer and a processor identifying from said records of promotions received by said consumer, based upon said identification information, one or more parameters related to said promotions received by said consumer (i.e. previous discount information for each customer is retrieved 314); a processor determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer (i.e. determining the time period to offer the second offer to the consumer based on previous offers redeemed by the customer)(col. 3, lines 49 to col. 4, lines 1-8).

With respect to claims 2, 42 Kepecs further teaches the one or more parameters related to said promotions received by said consumer relate to a packaging of said received promotions received by said consumer (i.e. grouping purchases as they relate to product categories for previous product purchased)(Figure 4 step 420).

With respect to claim 3, Kepecs further teaches the one or more parameters related to said promotions received by said consumer relate to a time at which said

promotions received were received by said consumers (i.e. timing the first promotions and based on that timing the second promotions)(col. 3, lines 49 to col. 4, lines 1-3).

With respect to claims 4, 5, Kepecs further teaches that one or more parameters related to said promotions received by said consumer relate to a product class/product industry of said promotions received by said consumer (Figure 4, step 424).

With respect to claim 7, Kepecs further teaches wherein said one or more parameters related to said promotions received by said consumer relate to the value of said promotions received (i.e. using price/value for making a determination of current discount)(see Figure 4, steps 406 and 408).

Claim 8 and 37 further recites a promotion validity date (i.e. offer expiration date)(col. 11, lines 12-19).

With respect to claims 9-11, Kepecs further teaches wherein one or more parameters related to said promotions received by said consumer relate to other purchases necessary to receive to exercise said promotions received (i.e. accumulated purchases 114-b is taken into account to generate the offers).

With respect to claim 13, Kepecs further teaches the step of identifying one or more parameters comprises determining if said consumer is appropriate for said

promotion, said promotion being determined (i.e. generate a consumer who should receive the offer) (see Figure 10).

With respect to claim 14, Kepecs teaches providing said promotion at said determined time to said identified consumer (Figure 11).

With respect to claim 15, Kepecs further teaches using said received identification information to identify said consumer (i.e. identifying when a first offer was received and purchase history for the consumer)(Figure 11, 114b and col. 3, lines 49 to col. 4, lines 1-3).

With respect to claim 16, Kepecs further teaches selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion (Figure 11, 114b and col. 3, lines 49 to col. 4, lines 1-3, col. 5, lines 61 to col. 6, lines 1-3).

With respect to claims 17-18 Kepecs further teaches selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile (i.e. the promoter matching the promotions to the consumer profile) (col. 3, lines 2-35 and col. 5, lines 61 to col. 6, lines 1-3).

With respect to claims 26, 33-36, 39-40 and 44-45, Kepecs further teaches determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase characteristic of said consumer (using database 114 to determine consumer demographic and purchase behavior); using a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record characteristics of said consumer or a processor configured to determine said promotion time at least in part based upon said record or characteristics of said consumer contained in said consumer characteristic record (i.e. POS for outputting targeted customer's promotions at a predetermined time based on customer's response to previous promotions)(col. 6, lines 29-58 and col. 3, lines 49 to col. 4, lines 1-8).

With respect to claim 37 further recites a promotion validity date (i.e. offer expiration date)(col. 11, lines 12-19).

With respect to claim 30, Kepecs further teaches means for providing said promotion at said time determined by said means for determining to said consumer identified by said means for identifying (Figure 11, 114b and col. 3, lines 49 to col. 4, lines 1-3, col. 5, lines 61 to col. 6, lines 1-3).

With respect to claim 31, Kepecs further teaches means for selecting a targeted promotion from a plurality of potential promotions based upon said one or more

characteristics of said consumer, said time determined by said means for determining being for said targeted promotion (Figure 11, 114b and col. 3, lines 49 to col. 4, lines 1-3, col. 5, lines 61 to col. 6, lines 1-3).

Claims 12, 32 Kepecs further teaches that one or more parameter related to said promotions received by said consumer relate to a promoter who is the source of said promotions received (i.e. keeping track of the seller where the coupons/offer came from)(col. 13, lines 13-22)

With respect to claim 41, Kepecs further teaches said received promotions record comprises a received promotion provision method record (i.e. recording the provision of the prior received promotions)(Figure 3, step 314).

With respect to claims 46, 63, 65 a computer readable medium containing program instructions for execution on a computer system, which when executed by the computer system, cause the computer system to perform the method recited, the determination being made in a computer system by a digital processor (Figures 1-2).

Claim 43 further recites that the promotions have a time of receipt record (i.e. delivery time of the offer)(Figure 3).

With respect to claims 59-61, Kepecs further teaches that the receiver is at a vendor location site at a check-out counter in a store (col. 6, lines 29-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 22, 38, 47-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kepecs.

Claim 6, 22, 38 further recites that the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer, the offer having a valid location code. Official notice is taken that it is old and well known for promotions to have a location code in which it can be redeemed in order to promote patronage of an establishment. It would have been obvious a person of ordinary skill in the art at the time of Applicant's invention to have included the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer in order to obtain the above mentioned advantage.

Claims 47-58 recite well known forms and methods of distributing offers and would therefore have been obvious to one of ordinary skill in the art to use such a known form of advertisement. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in Kepecs the well known forms and methods of distributing offers in order to provide variety and diversity in the way the offers are distributed.

Response to Arguments

7. Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
11/22/2009